

REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Claim Rejections – 35 USC § 103

At page 3 of the Office Action, the Examiner rejects claims 1 to 16 as being unpatentable over Shigenaga (US Patent No. 4,710,613).

Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

Obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The Examiner states on page 4 that:

"However, Examiner submits that the claimed invention recites an intended use, although Shigenaga fails to discuss the intended use which is the untrusted authentication is contained within a consumable device and the trusted authentication chip is contained within a consuming device, Shigenaga's authentication protocol is capable for validating the authenticity of the untrusted authentication chip as claiming in the claimed invention. Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Shigenaga to include the feature above for the purpose of validating the authenticity of the untrusted authentication chip in a specific product such as consumable device"

We respectfully submit that it would not have been obvious to include Shigenaga's authentication protocol for authenticating a consumable device.

Existing solutions for authenticating consumables have typically relied on physical patents on packaging. However, this does not stop inferior refill operations or clone manufactures. Thus, it would not have been obvious to modify Shigenaga with knowledge generally available to one of ordinary skill in the art, as the knowledge generally available for authenticating consumables would have been authenticating consumables via the packaging of the consumable, and not using encryption/decryption techniques between the consumable and the consuming devices.

If the Examiner wishes to maintain such an obviousness objection, the Examiner should cite prior art documentation in order to support such a statement of obviousness for consumable products, as Shigenaga fails to teach such a purpose.

In regard to claim 2, the Examiner has stated "*Shigenaga does not disclose the random number is not secret*". However, in the rejection the Examiner fails to provide any motivation or suggestion as to why one would modify Shigenaga to have a random number which is not secret.

Shigenaga states at lines 45 to 65 that the generated random number is encrypted and not transferred to the card. Thus, the random number is secret. Therefore Shigenaga teaches the very opposite to claim 2.

The MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

The Examiner has failed to provide any suggestion or motivation that it would be obvious to modify Shigenaga such that the random number is not secret. Furthermore, the Examiner has failed to provide any reasonable expectation of success based on the Shigenaga.

Additionally, the Examiner has failed to show that the prior art reference teaches or suggests all the claim limitations, that being that the random number is not secret.

Reconsideration and withdrawal of the rejection is respectfully requested.

The Applicant also submits herewith an Information Disclosure Statement listing cited documents relating to this application.

CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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